

REMARKS

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

Status of the Claims

Claims 1-16 are pending. Claims 1, 4, 6-8, 11 and 13-16 have been amended. No new matter has been added.

Independent claims 1, 8 and 16 have been amended to recite that the “personal certificate” can be “at least one of a card type or a book type.” Support for this amendment can be found in the Specification, at page 1, lines 8-9.

Other amendments to claims 1, 4, 6-8, 11 and 13-16 were made to more distinctly claim the subject matter recited therein, and are of an idiomatic nature. Therefore, there is no narrowing of the subject matter contained therein.

Rejection Under 35 U.S.C. § 103

Claims 1-4, 6-11 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,425,081 to Iwamura in view of U.S. Patent No. 6,421,450 to Nakano.

The Examiner contends that Iwamura discloses most of the features of claim 1. However, the Examiner acknowledges that Iwamura does not disclose “extracting the digital watermark and comparing it against the digital watermark stored in the database.” The Examiner cites Nakano as disclosing “a checker that checks whether the medium questioned is authorized by comparing the extracted watermark information with the retrieved watermark information,” and contends that Nakano’s disclosure of “a water mark data table” reads on the database of claim 1. (Detailed Action, item 4, page 3.) The Examiner states that it would have been obvious

to a person of ordinary skill in the art to combine Iwamura and Nakano to achieve the invention of claim 1.

Applicants submit that Iwamura discloses an image data delivery system 100 which includes an embedding server that delivers electronic watermark-embedded image data to a user. “The system 100 is a network, constituted by multiple entities” where “[t]he individual entities exchange digital data across the network.” (Iwamura, column 16, lines 36-41 and Figs. 3-4.)

As clearly recited, the claimed invention is directed to personal certificates, personal certificate issuing systems, and justification authenticating systems. A personal certificate is a type of card or a type of book, which is able to be provided separately from other elements of the issuing system. As would be understood by a person of ordinary skill in the art, non-limiting examples of a personal certificate include credit cards, debit cards, passport, etc. The personal certificate contains the readable authentic image in which a digital watermark authenticating an identifier is embedded.

Claim 1 recites “a personal certificate, which is at least one of a card type or a book type, containing said identifier.” In contrast, Iwamura merely discloses a system for delivering electronic watermark-embedded image data across a network. Iwamura does not disclose a personal certificate, as recited in claim 1.

Independent claim 8 recites a personal certificate where “the personal certificate is at least one of a card type or a book type.” Although the Examiner does not specifically state the particular basis for rejecting claim 8, Applicants submit that Iwamura fails to disclose this feature of claim 8 for at least the same reasons demonstrated above.

Applicants submit that Nakano does not disclose nor suggest those features of claims 1 and 8 demonstrated above to be missing from Iwamura. Therefore, Iwamura and Nakano

neither disclose nor suggest, singly or in combination, the invention of claims 1 and 8. Thus, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 1 and 8.

Claims 2-4, 6 and 7 depend from claim 1, and recite the features of claim 1 as if set forth therein. Claims 9-11 and 13-15 depend from claim 8, and recite the features of claim 8 as if set forth therein. Applicants submit that claims 2-4, 6, 7, 9-11 and 13-15 are patentable over Iwamura and Nakano for at least the same reasons as their respective base claims.

Additionally, claim 13 recites that the “authentic image of said personal certificate is updated according to predetermined timing.” Claim 14 recites that the “predetermined timing includes each time said system correctly justifies an authentic image.” Applicants submit that Iwamura and Nakano neither disclose nor suggest, singly or in combination, the inventions of claims 13 and 14.

Reconsideration and withdrawal of the rejection is requested.

Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwamura and Nakano in view of U.S. Patent No. 6,778,678 to Podilchuk.

The Examiner acknowledges that Iwamura and Nakano does not disclose, or suggest, “having the element of the digital watermark randomly generated.” (Detailed Action, item 8, page 4.) However, the Examiner cites Podilchuk as disclosing this feature. The Examiner states that it would have been obvious to a person of ordinary skill in the art to combine Iwamura, Nakano and Podilchuk to achieve the invention of claims 5 and 12.

Claim 5 depends from claim 1, and recites the features of claim 1 as if set forth in their entirety therein. Claim 12 depends from claim 8, and recites the features of claim 8 as if set forth in their entirety therein. Applicants submit that Podilchuk neither discloses nor suggests

those features of claims 5 and 12 missing from the combination of Iwamura and Nakano, as demonstrated above for claims 1 and 8. Therefore Iwamura, Nakano and Podilchuk neither disclose nor suggest, singly or in combination, the invention of claims 5 and 12. Thus, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 5 and 12. Reconsideration and withdrawal of the rejection is requested.

Rejection Under 35 U.S.C. § 102

Claim 16 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Iwamura.

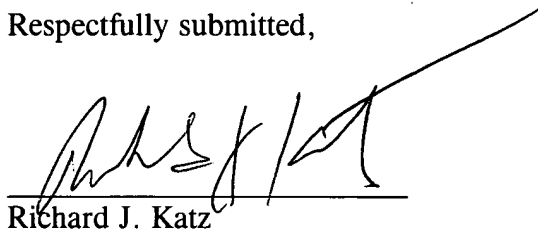
Claim 16 is directed to a personal certificate, and has been amended to recite that the personal certificate comprises “a card or a book.” As demonstrated above, Applicants submit that Iwamura does not disclose a personal certificate that includes “a card or a book,” as recited in amended claim 16. Therefore, Iwamura does not disclose each and every element of claim 16. Thus, Iwamura does not anticipate claim 16. Reconsideration and withdrawal of the rejection is requested.

CONCLUSION

Each and every point raised in the Office Action dated February 3, 2005 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-16 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Richard J. Katz', is written over a horizontal line.

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